

REMARKS

Claims 1-16 are currently pending in the subject application and are presently under consideration. Claims 1, 10, 11, and 15 have been amended as shown on pp. 2-4 of the Reply. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 2, 4, 6-8 and 10-16 Under 35 U.S.C. §103(a)

Claims 1, 2, 4, 6-8 and 10-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Uchida (US Patent 5,067,573). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Uchida does not disclose, teach or suggest each and every limitation set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. See MPEP §706.02(j). The ***teaching or suggestion to make the claimed combination*** and the reasonable expectation of success ***must be found in the prior art and not based on the Applicant's disclosure***. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The claimed invention relates to systems and methods for employing a terminal housing as part of a portable scanner unit as to increase utility and add ruggedness. In particular, independent claim 1 *recites a portable hand-held data terminal comprising a top portion, a bottom portion attached to the top portion, the bottom portion comprising a handle with a stylus compartment therein, **the handle comprises a pistol-grip**, and a stylus of the portable terminal housed within the stylus compartment*. Similarly, independent claims 10, 11, and 15 recite holding means for holding the portable terminal ***within a clenched fist of a user's hand*** (claim 10), ***a pistol-grip handle*** that fits in the closed fist of a user's hand (claim 11) and a handle

adapted to *fit in a user's closed hand* (claim 15). Uchida does not teach or suggest such claimed aspects.

Rather, Uchida relates to an electronic tablet which receives handwritten input via an input pen. The tablet includes a receptacle for the input pen and a detector that detects the presence of the pen in the receptacle. A warning signal is generated when the pen is absent from the receptacle at times when it should be housed. (*See* Abstract). However, Uchida does not disclose, teach or suggest a pistol-grip handle that fits within a clenched fist of a user's hand with a stylus compartment in the handle as recited by the claimed invention. In Uchida, the receptacle for the input pen is sandwiched between the top and bottom housing parts of a rectangular box-shaped tablet or slate and is not located in a pistol-grip handle. Moreover, the rectangular box shaped tablet is adapted to be comfortably held in the open hand of the user. Uchida is silent regarding a handle that fits in the closed hand of the user with a stylus compartment therein as recited in the subject claims. Thus, Uchida does not disclose, teach or suggest applicants' claimed invention.

In the subject Office Action, the Examiner contends that it would be obvious to modify the tablet of Uchida to a hand-held data terminal as claimed in the subject invention. The Examiner appears to be taking Official Notice of facts not specifically supported by the cited references and apparently considers such as "well known" or common within the art. Applicant's representative traverses the Official Notice and respectfully requests showing of reference(s) under M.P.E.P. § 2144.03 to support the Examiner's assertion, or in the alternative, withdrawal of this assertion from the rejection.

Applicants' representative respectfully submits that the rationale proffered in the Office Action is an unacceptable and improper basis for rejection of applicants' claimed invention under 35 U.S.C. §103. In essence, the Office Action bases the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the CAFC; *see, e.g., Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

Nonetheless, applicants' representative respectfully submits that it is not obvious to modify Uchida in the manner suggested in the subject Office Action. Uchida discloses various retention and detection means of the input pen. (*See* col. 5, line 38 – col. 9, line 14 and Figs. 6-

9B). These means are intended to be utilized in a rectangular box-shaped tablet such as that disclosed in Uchida. Furthermore, Uchida relates to a hand-held device for receiving handwritten input. The tablet device is a rectangular box shaped adapted to be held similar to a book or a piece of paper so that a user can comfortably and naturally write on the tablet input panel. Attempting to modify Uchida by adding a handle would not allow the retention and detection means to function as intended by Uchida nor could the user comfortably hold the device for writing like a book or piece of paper. Therefore, such a modification is not obvious in light of Uchida.

In view of at least the forgoing, it is respectfully submitted that Uchida does not teach or suggest applicants' claimed invention as recited in independent claims 1, 10, 11, and 15 (and dependent claims 2, 4, 6-8, 12-14, and 16 which depend there from). Accordingly, it is respectfully submitted that the subject invention is not obvious in light of Uchida and therefore it is requested that this rejection be withdrawn.

II. Rejection of Claims 3, 5, and 9 Under 35 U.S.C. §103(a)

Claims 3, 5 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Uchida in view of Ehrhart *et al* (U.S. 6,722,569). It is respectfully requested that this rejection be withdrawn for at least the following reason. Claims 3, 5, and 9 depend from independent claim 1 and Ehrhart *et al.* does not rectify the aforementioned deficiencies presented by Uchida with respect to independent claim 1, as discussed above. Accordingly, withdrawal of this rejection and allowance of claims 3, 5 and 9 is respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [SYMBP160USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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